Timeline for Implementation of the Leahy-Smith America Invents Act ("AIA")

September 16, 2011
AIA enactment date

Many changes in effect immediately

September 26, 2011
(10 days after enactment)
Prioritized examination fee and surcharge on all PTO fees (AIA § 11(h), (i))

Before September 16, 2012
Final rules for implementation of changes becoming effective on September 16, 2012

September 16, 2012
(1 yr after enactment)
Many changes including post-grant proceedings

March 16, 2013
(18 months after enactment)
Many changes including first-to-file (see below)

March 16, 2012
Establishment of Diversity of Applicants Program

On or before September 16, 2014
(PTO has to establish 3 or more satellite Offices (AIA § 23(a))

Reports Mandated by AIA

• First-to-Invent (AIA §3 (35 U.S.C. §§ 100, 102, 103))
• Derivation proceedings (for first to invent cases) (AIA §3 (35 U.S.C. § 291))
• Repeal of Statutory Invention Registration (AIA §3 (35 U.S.C. § 104))
• International Protection of Small Business Report (1/14/2012) (AIA § 31)
• Prior User Rights Report (1/16/2012) (AIA §3)
• Genetic Testing Report (6/16/2012) (AIA §27)
• Report on Misconduct before Office (9/13/2013) (AIA §3)
• Effects of First-to-File on Small Business Report (9/16/2012) (AIA §3)
• Patent Litigation Report (9/16/2012) (AIA §34)
• Virtual Marking Report (9/16/2014) (AIA § 16)
• Satellite Office Report (9/30/2014)
• AIA Implementation report (9/16/2015)

Changes effective September 16, 2011

• Pro Bono Program (AIA §32)
• Changes of threshold for Inter Partes reexamination (AIA §6)
• Tax strategies within prior art (AIA §14)
• Removal of best mode as grounds to invalidate patent (AIA §15 (35 U.S.C. § 282))
• Prohibition against patenting human organisms (AIA §33)
• Virtual and false marking (AIA §16 (35 U.S.C. § 287(a)))
• Establishment of OED Statute of Limitations (AIA §3)
• Fee Setting Authority (AIA §10 (35 U.S.C. § 41(d)))
• Establishment of micro-entity (AIA §10 (35 U.S.C. § 123))
• Joinder of defendants for ANDA cases under 271(e)(2) (AIA §19 (35 U.S.C. § 299))
• Joinder of parties (AIA §19 (35 U.S.C. § 299))
• Expansion of prior user rights to any process or instrumentality (AIA § 5 (35 U.S.C. § 282(b)))
• Calculation of 60-day period for application of patent term extension (AIA § 5 (35 U.S.C. § 156(d)(1)))
• Inventor’s Oath (AIA §4 (35 U.S.C. § 115))

Changes effective September 16, 2012

• Revised requirements for inventor’s oath of declaration (AIA §4 (35 U.S.C. § 115))
• Third party submission prior art submission for any patent/pending application (AIA §8 (35 U.S.C. § 122))
• Supplemental examination for any patent/pending application (AIA §12 (35 U.S.C. § 252))
• Citation of prior art in patent file (AIA §6 (35 U.S.C. § 301))
• Priority examination of important technologies (AIA §25 (35 U.S.C. § 2(b)(2)))
• Inter partes and post-grant review (AIA §6 (35 U.S.C. §§ 311-239))
• Transitional program for business method patent (AIA §18)
• Establishment of Ombudsman for Small Business Program (AIA §28)

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